



MS APPEAL BRIEF - PATENTS  
PATENT  
0905-0206P

IN THE U.S. PATENT AND TRADEMARK OFFICE

In re application of                      Before the Board of Appeals  
Yoshiko SHIIMORI et al.                  Appeal No.:

Appl. No.:              09/107,486                      Group:              2624  
Filed:                      June 30, 1998                      Examiner: K. Poon  
Conf.:                      8134  
For:                      IMAGE COMMUNICATION SYSTEM AND METHOD

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Technology Center 2600

REPLY BRIEF TRANSMITTAL FORM

**MS APPEAL BRIEF - PATENTS**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

December 18, 2003

Sir:

Transmitted herewith is a Reply Brief (in triplicate) on behalf of the appellants in connection with the above-identified application.

☐ The enclosed document is being transmitted via the Certificate of Mailing provisions of 37 C.F.R. § 1.8.

The Examiner's Answer was mailed on October 22, 2003.

☐ An extension of time under 37 C.F.R. § 1.136(b) to                      was requested on                      and was approved on                      .

☐ Please charge Deposit Account No. 02-2448 in the amount of \$0.00. A triplicate copy of this sheet is attached.

Appl. No. 09/107,486

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By 

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Attachment(s)

(Rev. 09/30/03)

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PATENT  
0905-0206P

**BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

IN THE U.S. PATENT AND TRADEMARK OFFICE

In re application of  
Yoshiko SHIIMORI et al.

Before the Board of Appeals

Serial No.: 09/107,486

Art Unit: 2624

Filed: June 30, 1998

Examiner: K. Poon

For: IMAGE COMMUNICATION SYSTEM AND METHOD

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**REPLY BRIEF UNDER 37 C.F.R. § 1.193(b)** Technology Center 2600

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

December 18, 2003

Sir:

Appellants submit herewith a Reply Brief in triplicate as required by 37 C.F.R. 1.192. This Reply Brief responds to the Examiner's Answer dated October 22, 2003.

For clarity, the issues presented in the Appeal Brief filed July 24, 2003 will be repeated, and the reply to the Examiner's Answer will substantially correspond structurally to the argument section in the Appeal Brief.

**I. ISSUES ON APPEAL:**

The issues to be resolved in this application are:

**A.** Whether claim 25 is unpatentable under 35 U.S.C. §103(a) over U. S. Patent No. 5,687,332 to Kurahashi et al. (hereafter Kurahashi) in view of U.S. Patent No. 6,370,280 to Cok et al. (hereafter Cok) and U.S. Patent No. 5,933,584 to Maniwa (hereafter Maniwa);

**B.** Whether claims 29 and 33 are unpatentable under 35 U.S.C. §103(a) over Kurahashi in view of Cok and U.S. Patent No. 5,764,235 to Hunt et al. (hereafter Hunt);

**C.** Whether claims 26, 30, 34-36, 38-43, 45-48 and 50 are unpatentable under 35 U.S.C. §103(a) over Kurahashi in view of Cok;

**D.** Whether claims 5-7 and 13-18 are unpatentable under 35 U.S.C. §103(a) over Hunt in view of Cok and Maniwa;

**E.** Whether claims 19, 20, 22-24, 27, 28, 31 and 32 are unpatentable under 35 U.S.C. §103(a) over Hunt in view of Cok;

**F.** Whether claims 10 and 12 are unpatentable under 35 U.S.C. §103(a) over U.S. Patent No. 5,720,013 to Uda et al. in view of Maniwa and Cok;

**G.** Whether claim 8 is unpatentable under 35 U.S.C. §103(a) over Hunt in view of Maniwa, Cok and Uda;

**H.** Whether claim 49 is unpatentable under 35 U.S.C. §103(a) over Uda in view of Maniwa, Cok and U.S. Patent No. 5,926,154 to Hirono; and

**I.** Whether claims 1-10, 12-18, 29 and 33 are rejected under §112, 1<sup>st</sup> paragraph.

**II. REPLY:****Issue A.****A. The Rejection Fails to Establish Prima Facie Obviousness of Independent Claim 25.**

In responding to Appellants' argument that the references fail to teach or suggest all of the elements of the claimed invention and that there fail to be any motivation for combining Cok's film image data with Kurahashi's system, the Examiner concedes that Kurahashi fails to teach that the image data processed is film image data but responds that "for over a century, people in all ages, have been learned [sic] to use films for recording images. ...Cok's reference is being used to prove that it is well known in the art that images are being recorded onto photographic film. ...Since film images have been used by human for over a century to produce printed products, knowledge and the technology improvements over a century have allowed film images to be created in manner that is very flexible and are usable over a wide distribution to diverse producer for producing different print products."

The Examiner's motivation for combining Kurahashi with Cok is that it would have allowed the image to be created in a manner that is very flexible and is usable over a wide distribution to diverse producers and the film image would have allowed users to create realistic images with low cost.

However, appellants respectfully submit that the Examiner is misinterpreting the motive of Cok's method and is improperly associated it with Kurahashi's method. For example, Cok states that its object is to provide a method for controlling the use of artistic and personal images in composite imagery in a manner that

is very flexible, is useful over a wide distribution to diverse producers, inhibits fraud, and can be adapt to a variety of circumstances without compromising the secure use of the imagery. (see Cok, col. 2, lines 23-28). In other words, Cok is addressing the problem of security needs for composite image creations and concerned with controlling the distribution of such composite imagery. Therefore, when Cok speaks about a wide distribution to diverse producers, Cok is addressing security needs not the flow (speed) of image data.

As for Cok, the Examiner alleges that Cok teaches creating film image data to be stored in a server. However, the Examiner has failed to show where or how Cok discloses that the *information relating to the film image data* is transmitted to the image server, wherein this information that relates to the film image data is used to subject the film image data to display direction conversion. Cok merely transmits a personal image 18 and image control data 28 to the image production system 14. The image control data 28 that is transmitted by Cok merely represents a personal image code identifying the image as a personal image. (see Cok, col. 4, lines 17-20). The control data 28 taught by Cok does not represent data that can be used to subject the film image data to display direction conversion.

Furthermore, appellants respectfully submit that there fails to be any motivation for combining Cok's film image data with Kurahashi's system. For example, Kurahashi is concerned with image edit processing and reducing the amount of transfer data flowing in the network. In contrast to Kurahashi, Cok is merely concerned with controlling the production of composite images and addressing the different security needs of both the individual image components and the final composite image. The Examiner asserts that there is motivation to combine Cok with

Kurahashi because it would allow the image to be created in a manner that is flexible and is usable over a wide distribution to diverse producers and the film image would have allowed users to create realistic images with low cost.

However, appellants respectfully point out that the Examiner is merely reciting Cok's objectives for its own security based invention, which is not a recognized concern for Kurahashi. Appellants submit that from a close review of both Kurahashi and Cok, we find no teaching or suggestion to support the examiner's asserted motivation to combine the references so as to achieve the things recited above. The examiner's statement that it would allow the image to be created in a flexible manner usable over a wide distribution to diverse producers and that it would allow users to create realistic images at low cost is unsupported because the examiner has not established that the above-noted issues are a factor even recognized by Kurahashi. Kurahashi is not at all concerned with diverse producers or realistic images. Furthermore, the nature of the problems to be solved in Cok and Kurahashi are completely different.

The Examiner further indicates that Kurahashi as modified by Cok still does not teach the claimed image output device that outputs the film image after subjecting the film image to display direction conversion, as set forth in claim 25. In an attempt to show this feature, the Examiner imports the additional reference of Maniwa and alleges that Maniwa teaches outputting images after subjecting the image to display direction conversion. The Examiner then states that it would have been obvious to combine Maniwa with Kurahashi/Cok because it would have allowed the image to be displayed in a correct direction as taught by Maniwa. The Examiner further alleges that "since claim 25 does not

specifically claim a TV monitor type of display, the display of claim 25 is being interpreted broadly as displaying a printed image to a human observer."

As for Maniwa, Examiner alleges that Maniwa teaches outputting images after subjecting the image to display direction conversion. However, appellants respectfully submit that a close reading of Maniwa merely reveals that a facsimile server software has a filter function to rotate read image data before sending the image data to a print server software, and a function to automatically rotate an image when the paper feed direction in the printer is different from that of reading by the scanner, so that it is possible to easily realize a copying function. (see Maniwa, col. 29, lines 50-61). In other words, Maniwa discloses at most a rotational component for a print/copying function, not for a display function. No *display* direction conversion, as set forth in claim 25, is disclosed by Maniwa. Maniwa is only concerned with being able to print/copy an image according to the direction of the paper feed. Maniwa is completely silent about performing display direction conversion processing so as to *display* the image data properly. As such, appellants respectfully submit that the Office Action is inappropriately equating Maniwa's facsimile server functions directed to printing/copying with the claimed *display* direction conversion processing.

In contrast to the present invention as set forth in claim 25, appellants respectfully submit that the combination of Kurahashi, Cok and Maniwa fails to teach or suggest subjecting film image data to display direction conversion processing prior to transmitting it to the client computer, as recited in claim 25. Kurahashi merely discloses sending editing data information, such as resolution and color information, for display. (see

Kurahashi, column 8, lines 1-3). There is no mention about any type of display direction information in Kurahashi. Also, Cok is completely silent about display direction conversion processing. Furthermore, Maniwa only discloses rotating the image data to match the paper feed direction and fails to disclose any type of display conversions. Appellants respectfully submit that the Examiner's interpretation that a printed image to a human observer is a display as set forth in claim 25 is overreaching and inappropriate.

Further, appellants submit that not only does the combination of references fail to teach or suggest each and every feature but that the Examiner has failed to provide proper motivation for combining the three references, Kurahashi, Cok and Maniwa.

Appellants point out that an essential evidentiary component of an obviousness rejection is a teaching or suggestion or motivation to combine the prior art references. C.R. Bard, Inc. v. M3 Systems, Inc., 48 USPQ2d 1225 (Fed. Cir. 1998). Combining prior art references without evidence of a suggestion, teaching or motivation simply takes the inventors' disclosure as a blueprint for piecing together the prior art to defeat patentability -- the essence of hindsight. Interconnect Planning Corp. v. Feil, 227 USPQ 543 (Fed. Cir. 1985). Evidence of a suggestion, teaching or motivation to combine may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or in some cases, from the nature of the problem solved. In re Dembiczak, 50 USPQ2d 1614 (Fed. Cir. 1999). However, a rejection can not be predicated on the mere identification of individual components of the claimed limitations. In re Kotzab, 55 USPQ2d 1313 (Fed. Cir. 2000). Rather, particular findings must be made as to the reason the

skilled artisan, with no knowledge of the claimed invention would have selected these components for combination in the manner claimed. Id.

Appellants submit that even if all of the features were shown in the combination of Kurahashi, Cok and Maniwa, and appellants maintain that they are not, appellants respectfully submit that the Examiner has failed to show why a skilled artisan, with no knowledge of the claimed invention, would have selected the film image data from Cok and the outputting feature of Maniwa's printer to arrive at the claimed invention. Appellants submit that the Examiner has used nothing more than hindsight in order to combine Cok and Maniwa with Kurahashi, and has identified nothing in either reference that could be construed as a suggestion, teaching or motivation to combine all three of the cited references.

Thus, appellants respectfully submit that the Examiner's combination of references not only fails to teach or suggest each and every feature as claimed in claim 25, but the combination of references is improper and should be withdrawn for at least the reasons noted above.

Appellants respectfully submit that independent claim 25 is allowable over the combination of Kurahashi, Cok and Maniwa for at least the reasons noted above.

As such, Appellants maintain that the Examiner has failed to establish a *prima facie* case of obviousness.

#### **Issue B.**

B. The Rejection Fails to Establish Prima Facie Obviousness of Claims 29 and 33.

In responding to Appellants' argument that the references fail to teach or suggest all of the elements of the claimed invention and that there fail to be any motivation for combining Kurahashi with Cok and Hunt, specifically that Hunt fails to teach transmitting information corresponding to the number of colors of the display device, the Examiner responds that RGB is interpreted as a color display and that showing RGB, inherently also shows the number of the colors. RGB, in the Examiner's example being three different colors. (see page 32 of Examiner's Answer.)

Appellants respectfully submits that RGB does not inherently signify the number of colors being transmitted. Instead, RGB merely stands for red, green, and blue color axes to form an RGB color tube. The number of colors used in a display can vary from 256 to 65K, for example, and Hunt is completely silent about transmitting film image data corresponding to the number of colors of the display device, as set forth in claims 29 and 33.

For at least the above noted reasons, appellants respectfully submit that there fail to be proper motivation for combining the references and even if combined, the combination of Kurahashi, Cok and Hunt fails to teach or suggest each and every feature as set forth in the claimed invention.

As such, Appellants maintain that the Examiner has failed to establish a *prima facie* case of obviousness.

### Issue C.

C. The Rejection Fails to Establish Prima Facie Obviousness of Claims 26, 30, 34-36, 38-43, 45-48 and 50.

In responding to Appellants' argument that not only does there fail to be proper motivation for combining Kurahashi with

Cok as addressed above, but even if combined, the combination of Kurahashi and Cok fails to teach or suggest each and every feature as set forth in the claimed invention, specifically transmitting printing template film image data from the sever 56 to the client computer and the re-editing of the initially edited image based on a transmitted execution command, the Examiner responds that one can not show nonobviousness by attacking references individually where the rejection are based on combinations of references. (see page 33 of Examiner's Answer). The Examiner further argues that Kurahashi teaches a receiving device as claimed and a judging device as claimed.

Appellants respectfully submit that Cok merely discloses uploading film image data to an image fulfillment server 56 and the image fulfillment server 56 produces a hardcopy of the composite image. However, no printing template film image data is transmitted from the sever 56 to the client computer, as set forth in claims 26 and 30. Cok only discloses that billing and credit information is transmitted from the fulfillment server 56. (see Cok, col. 6, lines 2-4).

Furthermore, nothing in Kurahashi whatsoever is directed to re-editing of the initially edited image. Secondly, even assuming *arguendo* that Kurahashi does analyze editing data (col. 7, line 3), Kurahashi still does not judge whether initial editing or subsequent re-editing is allowed based on a transmitted execution command, as claimed. In col. 6 of Kurahashi (lines 45-56), all that is described are the elements and their functions as shown in Fig. 3. None of these elements teach a subsequent re-editing in any respect, especially re-editing based on a transmitted execution command.

As such, Appellants maintain that the Examiner has failed to establish a *prima facie* case of obviousness.

#### **Issue D.**

D. The Rejection Fails to Establish Prima Facie Obviousness of Claims 5-7 and 13-18.

In responding to Appellants' argument that the combination of Hunt, Cok and Maniwa fail to make up for the deficiencies found in each individual reference, the Examiner responds that Maniwa teaches to rotate a scanned image when the paper feed direction in the printer is different from that of the reading by the scanner. (see Examiner's Answer, page 34). The Examiner further argues that although Maniwa discloses a printer instead of a display monitor, the concept is the same. Appellants respectfully disagree with this analysis. Appellants respectfully submit that the Examiner is overreaching in his reading of Maniwa, which amounts to improper hindsight reconstruction.

Maniwa fails to teach or suggest display direction conversion processing, as set forth in the claimed invention; and Hunt fails to teach or suggest display information relating to the maximum number of colors which can be displayed on the display device. Because Hunt, Cok and Maniwa fail to make up for the deficiencies found in each individual reference, such a combination of references fail to teach or suggest each and every feature as set forth in the claimed invention.

As such, Appellants maintain that the Examiner has failed to establish a *prima facie* case of obviousness.

**Issue E.****E. The Rejection Fails to Establish Prima Facie Obviousness of Claims 19, 20, 22-24, 27, 28, 31 and 32.**

In responding to Appellants' argument that the combination of Hunt and Cok fail to teach or suggest each and every feature as set forth in the claimed invention and that there fail to be motivation for combining Hunt and Cok, the Examiner again relies on his above-noted interpretation of the meaning of RGB.

Again, appellants respectfully submits that RGB does not inherently signify the *number* of colors being transmitted. Instead, RGB merely stands for red, green, and blue color axes to form an RGB color tube. The number of colors used in a display can vary from 256 to 65K, for example, and Hunt is completely silent about transmitting film image data corresponding to the number of colors of the display device.

Furthermore, the Examiner has conceded that Hunt fails to teach or suggest the image data is film image data. In an attempt to make up for the deficiencies in Hunt, the Examiner has imported Cok. However, Cok merely discloses that a film image can be scanned into an order entry station 50 and the order entry station 50 is connected to an image server 56 that implements an image production system 14. As such, while Hunt is concerned with a technique for transmitting graphical images in a network while the amount of data transmitted is customized in accordance with client and/or server supplied information, Cok is merely concerned with controlling the production of composite images and addressing the different security needs involved. The transmission of Cok's film image to the image server is done without any regards to the amount of data transmitted. As such, the problems addressed by Hunt and Cok are completely different and applicants respectfully

submit that one of ordinary skill in the art would not have been motivated to combine the film image data of Cok with Hunt's system. The Examiner's motivation for combining the two references is unsupported because the Examiner has not established that the realistic images and diverse producers are factors even recognized by Hunt. Factors considered by Hunt include the amount of data being transmitted. Cok is not at all concerned with the amount of data transmitted. As such, appellants respectfully submit that the Office Action has failed to provide a proper motivation for combining Cok with Hunt.

Furthermore, Hunt discloses a handshake procedure wherein the server receives a request for graphical image from the client and also receives image control information. The server determines the appropriate amount of graphical data to transmit based on the control information and transmits the appropriate amount based on the control information. However, Hunt fails to disclose the client reducing film image data and transmitting the reduced data to the server. Cok also fails to disclose any type of reduction of film image data prior to transmission.

Because Hunt and Cok fail to make up for the deficiencies found in each individual reference, such a combination of references fail to teach or suggest each and every feature as set forth in the claimed invention.

As such, Appellants maintain that the Examiner has failed to establish a *prima facie* case of obviousness.

#### **Issue F.**

F. The Rejection Fails to Establish Prima Facie Obviousness of Claims 10 and 12.

In responding to Appellants' argument that the combination of Uda, Maniwa and Cok fails to make up for the deficiencies found in each individual reference, the Examiner responds that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. However, it seems that the Examiner has misread our "combination of" language in our arguments.

Specifically, the arguments made above and in our Appeal Brief concerning the deficiencies found in Maniwa are equally applicable here. The Examiner concedes that Uda and Cok fails to teach or suggest outputting the film image after subjecting the film image to display direction conversion so that the film image is displayed on the display in a correct direction. The Examiner has imported Maniwa in an attempt to make up for the deficiencies found in both Uda and Cok, however, as noted above, Maniwa also fails to teach the display direction conversion, as set forth in the claimed invention.

As such, Appellants maintain that the Examiner has failed to establish a *prima facie* case of obviousness.

#### **Issue G.**

##### **G. The Rejection Fails to Establish *Prima Facie* Obviousness of Claim 8.**

In responding to Appellants' argument that the combination of Hunt, Uda, Maniwa and Cok fails to make up for the deficiencies found in each individual reference, because the combination fails to teach or suggest each and every claimed feature, the Examiner appears to respond that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. Appellants submit that the

combination of cited references fail to teach or suggest each and every featured claimed in claim 8.

The arguments presented in the Appeal Brief and above pertaining to the deficiencies found in Hunt, Cok and Maniwa are also applicable to this rejection. Because Uda fails to make up for the above noted deficiencies noted in the combination of Hunt, Cok and Maniwa, claim 8 is allowable over the combination of Hunt, Uda, Maniwa and Cok.

As such, Appellants maintain that the Examiner has failed to establish a *prima facie* case of obviousness.

### **Issue H.**

#### **H. The Rejection Fails to Establish Prima Facie Obviousness of Claim 49.**

In responding to Appellants' argument that the combination of Uda, Maniwa, Cok and Hirono fails to make up for the deficiencies found in each individual reference, because the combination still fails to teach or suggest each and every claimed feature, the Examiner appears to respond that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references.

The arguments made in the Appeal Brief and above concerning the combination of Maniwa, Cok and Uda are also applicable to this rejection. Furthermore, Hirono fails to teach or suggest display direction conversion processing as set forth in claim 49. The Object of Hirono is to provide a double screen display device useful for users sitting face to face to each other. Hirono uses a view direction control unit for controlling the view direction of each picture element, with one view being symmetrical to the other. In other words, Hirono teaches that the two users sitting

face to face with the screen of the display device between them, they can see the image displayed on the screen as a normal image. However, Hirono fails to disclose that the server has a image data transmission device that transmits the display direction converted image data to the client computer, as set forth in claim 49. Hirono merely discloses that the server and the customer can see the image as a normal image, however, this is not the same as the server transmitting the display direction converted image data to the client computer, as set forth in claim 49. Because Hirono fails to teach the display direction converted image data and fails to make up for the deficiencies found in each of Maniwa, Cok and Uda, dependent claim 49 is allowable over such a combination of references.

As such, Appellants maintain that the Examiner has failed to establish a *prima facie* case of obviousness.

### **Issue I.**

#### **I. The Examiner Fails to Show How Claims 1-10, 12-18, 29 and 33 are Rejected under 112, 1<sup>st</sup> paragraph.**

In responding to Appellants' argument that the claims are indeed fully supported by the extensive disclosure, the Examiner responds that applicant has not specified how the first paragraph of 35 U.S.C. is complied with, including, how the specification and drawings describe the subject matter defined by each of the rejected claims. (see page 37 of Examiner's Answer).

Again, appellants point out that the Examiner has failed to address our comments pertaining to the 112, 1<sup>st</sup> paragraph rejection in the May 20, 2003 Advisory Action. As pointed out in appellants' previous arguments, support for the features

relating to the display conversion processing can at least be found on page 37 to page 38 of the present specification. Furthermore, the numerous other features cited by the Examiner as not being supported by the specification are clearly improper because such features are disclosed throughout the present specification. See for example at least, pages 43-47, pages 50-51, pages 71-73, pages 80-83, pages 85-86, pages 95-96, pages 104-107, pages 112-115, and Figs. 1, 24 and 31. The Examiner has fail to specifically respond to our citations of examples of the specification that describe the claimed invention.

Appellants respectfully point out to the Examiner that the claimed invention subject matter need not be described literally, i.e., using the same terms, in order for the disclosure to satisfy the description requirement. As long as the specification reasonably convey to those skilled in the art that the applicants was in possession of the claimed invention as of the date of the invention, then the written description requirement is satisfied, and appellants respectfully submit that the present disclosure does indeed reasonably conveys that the appellants were in possession of the claimed invention.

Accordingly, withdrawal of the rejection of claims 1-10, 12-18, 29 and 33 under 35 U.S.C. §112, 1<sup>st</sup> paragraph is respectfully solicited.

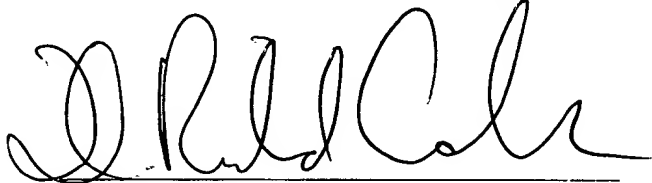
As such, Appellants maintain that the Examiner has failed to show how the claims contain subject matter that was not described in the specification in such a way as to reasonably convey to one skilled in the art that the inventors has possession of the claimed invention.

**III. CONCLUSION**

For all the reasons set forth above, the rejections in the Examiner's Answer dated October 22, 2003, are improper. It is therefore respectfully requested that the Examiner be reversed on all grounds.

Respectfully submitted,

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